

## REMARKS

### Summary of Office Action

Claims 1-20 were pending in this application.

Claims 1-20 were objected to for using the word "the" instead of "said" in front of claim limitations.

Claims 2, 7, and 17 were objected to for using the word "cancelling" instead of "canceling."

Claims 16-20 were rejected under 35 U.S.C. § 101 for non-statutory subject matter.

Claims 1-3, 5-8, 10-13, and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Young et al. U.S. Patent No. 5,353,121 ("Young") in view of Michaud U.S. Patent No. 6,057,874 ("Michaud").

Claims 4, 9, and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Young in view of Michaud, and further in view of Roop et al. U.S. Patent No. 5,619,274 ("Roop").

Claims 16-18, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Young in view of Michaud, and further in view of Klosterman et al. U.S. Patent No. 6,078,348 ("Klosterman").

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Young in view of Michaud and Roop, and further in view of Klosterman.

#### **Summary of Applicants' Reply**

Applicants have amended page 1 of the specification to include a status update for an earlier application to which applicants claim benefit. Applicants cancel claims 16-20 without prejudice. The Examiner's objections and rejections are respectfully traversed.

#### **Reply to the Objection to the use of "the"**

Claims 1-20 were objected to for using the word "the" instead of "said" in front of claim limitations to indicate existence of antecedent bases for those limitations.

In response, applicants submit that the MPEP teaches the use of "the" to refer to antecedent bases. In particular, MPEP § 706.03(d) ¶ 7.34.05, which provides an example on how to phrase objections based on lack of antecedent basis, recites: "Claim [1] recites the limitation [2] in [3]. There is insufficient antecedent basis for this limitation in the claim. . . . In bracket 2, insert the limitation which lacks antecedent basis, for example --said lever-- or --the lever--."

(Emphasis added.) Thus, the MPEP authorizes applicants to use the word "the" instead of "said" in applicants' claims. Accordingly, the objections of the claims based on applicants' use of the word "the" instead of "said" are improper and should be withdrawn.

#### **Reply to Objection to the use of "cancelling"**

Claims 2, 7, and 17 were objected to for using the word "cancelling".

In response, applicants submit that "cancelling" is a proper conjugation of the verb "cancel." See Merriam-Webster's Collegiate Dictionary, 10th Ed., p. 165.

In addition, the MPEP itself uses the word "cancelling." In particular, MPEP § 1879.II recites: "The replacement sheets (but not replacement sheets superseded by later replacement sheets) or letters cancelling sheets under Rule 66.8(a) are included as an annex to the report."

(Emphasis added.) Accordingly, the objections to applicants' use of the word "cancelling" in the claims should be withdrawn because these objections are improper and meritless.

#### **Reply to the 35 U.S.C. § 101 Rejection**

Claims 16-20 were rejected under 35 U.S.C. § 101 for non-statutory subject matter.

Applicants respectfully disagree with the rejection. In the interest of expediting allowance of this case, however, applicants have canceled claims 16-20 without prejudice. Applicants also reserve the right, if necessary, to show in later proceedings that these claims are directed towards statutory subject matter.

#### **Reply to the § 103(a) Rejections**

Claims 1-3, 5-8, 10-13, and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Young in view of Michaud. The rejection is respectfully traversed.

Applicants' independent claims 1, 6, and 11 are directed towards an interactive program guide system that provides an interactive television program guide and includes a video recorder and a television. The system receives television program guide information for use in the interactive television program guide. It determines whether the video recorder and television are a combined unit. The system selects a program for recording from the interactive television program guide. It also displays a message prior to recording

the selected program when the video recorder and television are a combined unit that informs the user that recording is to begin and asks the user whether to continue with recording.

The Examiner acknowledges that Young "does not teach means for determining whether the video recorder and television are a combined unit" (Office Action, page 9, last two lines). To fill this void, the Examiner relies on Michaud and contends that "Michaud teaches means for determining whether the video recorder and television are a combined unit (column 4 lines 49-63)" (Office Action, page 10, lines 1-2).

Michaud is directed to "delivering selective VCR control codes to programmable settop terminals over a CATV communication system" (Michaud column 2, lines 13-15). In particular, the user enters a VCR's manufacturer and model number, and Michaud's settop terminal downloads the corresponding VCR control codes (Michaud column 4, lines 37-59). The settop terminal uses the control codes to control the VCR, typically by transmitting instructions using an IR transmitter (Michaud column 1, lines 40-47).

Michaud, like the other documents cited by the Examiner, fails to show or suggest how a VCR control code is related to whether or not a device is a combined unit, let alone explain how control codes can enable a system to

determine whether a VCR and a television are a combined unit. For at least this reason, Michaud does not show or suggest any system or method for determining whether a VCR and a television are a combined unit. Because Michaud fails to show or suggest all of the features of applicants' claims, it fails to fill the void left by Young.

For at least the foregoing reasons, applicants respectfully submit that independent claims 1, 6, and 11 are patentable over Young and Michaud, whether taken alone or in combination. Claims 2-3, 5, 7-8, 10, 12-13, and 15, which depend from independent claims 1, 6, or 11, are also patentable over Young and Michaud for at least the reasons that independent claims 1, 6, and 11 are patentable over Young and Michaud. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP § 2143. Accordingly, applicants respectfully request that the rejection of claims 1-3, 5-8, 10-13, and 15 under 35 U.S.C. § 103(a) be withdrawn.

Claims 4, 9, and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Young in view of Michaud, and further in view of Roop. These claims depend from independent claims 1, 6, or 11, which are patentable over Young

and Michaud. Accordingly the rejections of claims 4, 9, and 14 should be withdrawn.

The cancellation of claims 16-20 renders the rejection of these claims under 35 U.S.C. § 103(a) moot.

### **Conclusion**

For at least the foregoing reasons, claims 1-15 are allowable. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,

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